

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

TERAD-8-US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

10/608,588

Filed

06-27-2003

First Named Inventor

Evgeny Polyakov

Art Unit

2616

Examiner

Mark A. Mais

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Bruce D. Rubenstein #39,349/

Signature

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Bruce D. Rubenstein

Typed or printed name

☐ attorney or agent of record.

Registration number _____

781-274-0202

Telephone number

☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 39,349

September 4, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to life (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application
Docket Number: TERAD-8-US

In Re: POLYAKOV, Evgeny
Serial No: 10/608588
Filed: 6/27/2003
For: FLEXIBLE APPROACH FOR
REPRESENTING DIFFERENT
BUS PROTOCOLS

Group: 2664
Examiner: MAIS, Mark A.

September 4, 2007

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This Pre-Appeal Brief Request for Review is submitted in response to a FINAL Office Action mailed June 4, 2007, in connection with the above-identified patent application. A Notice of Appeal, corresponding fee, and Request Form PTO/SB/33 are submitted herewith.

The Examiner has at least twice rejected each of independent claims 1, 25, and 26 under 35 U.S.C. § 102(b) as being anticipated by Baker et al. (USP. 6,266,700, hereinafter, "Baker"). A review of the rejections of these claims is hereby requested. As Applicant demonstrates below, Baker does not meet all of the elements of any of the rejected independent claims. The Examiner has failed to make a *prima facie* case for rejecting any of the independent claims. The claims are discussed in turn. Reference is made to Applicant's most recent amendment, dated January 22, 2007 (hereinafter, "Amendment"), and to the Examiner's subsequent FINAL Office Action, dated June 6, 2007 (hereinafter, "FINAL Office Action").

CLAIM 1

The FINAL Office Action has failed to present a *prima facie* case for rejecting claim 1. Claim 1 is directed to “a method of testing equipment connected to a target medium having a protocol.” Claim 1 recites, *inter alia*, the step of—

providing an electronic instrument for operatively connecting to the equipment over the target medium and operating under control of a software program [.]

Both an “electronic instrument” and a “software program” are recited. Yet the FINAL Office Action asserts that Baker’s single “logic control module” corresponds to both of these elements. This is clearly erroneous. Baker discloses that the logic control module may be implemented in either software or hardware (see Abstract). However, Baker does not disclose that it may be implemented in both software *and* hardware. And Baker certainly does not disclose that the logic control module is implemented in two parts, where the hardware part operates “under control” of the software part. Therefore, an element is missing from the rejection.

Claim 1 also recites, *inter alia*, the steps of—

instantiating, by the software program, at least one of the plurality of communication element types to create a transmit message instance; [and]

instantiating, by the software program, at least one of the plurality of communication element types to create an expect message instance [.]

The rejection of claim 1 set forth in the FINAL Office Action fails to meet these limitations. As is known, “instantiation” is a software programming term that describes the creation of specific “instances” from prototypes or templates. Applicant has discussed the meaning and significance of “instantiation” at page 3, paragraphs 3-5 of the Amendment. Although Baker’s system may be implemented in software (or hardware, see Summary of the Invention), the concept of instantiation is not discussed and is not part of Baker’s system. Therefore, Baker does not meet all the limitations of claim 1.

As recited in claim 1, the software program creates the “transmit message instance” and the “expect message instance” by “instantiating” communication element types. The Examiner alleges that “communication element types” can be found in Baker’s programmably configurable protocol descriptions (see page 3, ¶2 of the FINAL Office Action). Yet the rejection does not allege any link between Baker’s protocol

descriptions and any transmit or expect message instances. Without this link, Baker cannot perform the “instantiating” steps and there can be no anticipation of claim 1.

In addition, the rejection of claim 1 lacks particularity. In forming the rejection, the Examiner lumps together the two “instantiating” steps above, along with 2 other steps (“directing” and “comparing”). The Examiner asserts that Figs. 11-16 of Baker and accompanying text meet all of the elements recited in these four clauses of claim 1 (see page 4, ¶1 of the FINAL Office Action). Explicit connections are not made, however. One cannot know by reading the rejection how the various teachings of Baker relate to particular language in the claim.

Therefore, and for at least the foregoing reasons, the rejection of claim 1 under 35 U.S.C. § 102(b) is improper and should be withdrawn.

CLAIM 25

Many of the mistakes in rejecting claim 1 have been repeated in rejecting claim 25. Once again the FINAL Office Action has applied the single “logic control module” of Baker against two separate and distinct claim elements (See p. 7 of the FINAL Office Action). Claim 25 recites, *inter alia*,

providing an electronic instrument for operatively connecting to the target medium for communicating over the target medium; [and]

providing a software program for controlling the electronic instrument [.]

Although Baker’s “logic control module” may be implemented in either hardware or software (see Abstract), Baker nowhere teaches that it may be implemented as both hardware *and* software, or that the software part controls the hardware part. An element is missing from the rejection. Baker therefore fails to meet all the limitations of claim 25.

Claim 25 also recites, *inter alia*, a step of “instantiating at least one of the plurality of communication element types by the software program to create at least one communication element instance.” However, the FINAL Office Action has failed to identify anything in Baker that corresponds to this “instantiating” step. Once again, the Examiner makes general reference to Baker’s Figs. 11-17 and accompanying text (see page 9 of the FINAL Office Action). However, none of this relates to instantiation.

Also, as recited in claim 25, the “communication element instance” is created by instantiating a communication element type. Yet the rejection fails to allege any link

between Baker's protocol descriptions (what the Examiner alleges are equivalent to Applicant's communication element types) and any communication element instance. Without this link, the requirements of the "instantiating" step cannot be met and there can be no anticipation of claim 25.

Therefore, and for at least the foregoing reasons, the rejection of claim 25 under 35 U.S.C. § 102(b) is improper and should be withdrawn.

CLAIM 26

Similar errors to those presented in connection with claim 25 have been made in rejecting claim 26. For example, Baker's single "logic control module" has again been applied against two separate and distinct claim elements (See p. 11 of the FINAL Office Action). Claim 26 recites, *inter alia*,

providing an electronic instrument operatively connecting to the target medium for communicating over the target medium; [and]

providing a software program for controlling the electronic instrument [.]

Although Baker's "logic control module" may be implemented in either hardware or software (see Abstract), Baker nowhere teaches that it may be implemented as both hardware *and* software, or that the software part controls the hardware part. Therefore, an element is missing from the Examiner's rejection. Baker therefore fails to meet all the limitations of claim 26.

Claim 26 also recites, *inter alia*, a step of "instantiating the at least one message type by the software program to create at least one message instance." However, as with claim 25, the FINAL Office Action has failed to identify anything in Baker that corresponds to this "instantiating" step.

Also, as recited in claim 26, the "message instance" is created by instantiating a message type. Yet the rejection does not allege any link between Baker's protocol descriptions (what the Examiner alleges are equivalent to Applicant's message types) and any message instance. Without this connection, there can be no anticipation of claim 26.

Therefore, and for at least the foregoing reasons, the rejection of claim 26 under 35 U.S.C. § 102(b) is improper and should be withdrawn.

A great deal more could be included about the differences between Applicant's claims and the Baker reference. However, the scope of this pre-appeal brief request is necessarily limited, so additional discussion of these differences is withheld at this time without prejudice to future arguments.

Conclusion:

Applicant contends that the application is in condition for allowance. A notice to that effect is earnestly solicited.

Respectfully Submitted,

/Bruce D. Rubenstein #39,349/

Bruce D. Rubenstein
Reg. No. 39,349
Attorney for Applicant

Atty. Docket : TERAD-8-US
Telephone : 781-274-0202
Fax : 781-274-0201